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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,274	02/05/2001	Jean Paul Marcade	06-00939US07	3685

54953 7590 11/24/2009  
BROOKS, CAMERON & HUEBSCH, PLLC  
1221 NICOLLET AVENUE  
SUITE 500  
MINNEAPOLIS, MN 55403

EXAMINER
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WILLSE, DAVID H

ART UNIT	PAPER NUMBER
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3738

MAIL DATE	DELIVERY MODE
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11/24/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/777,274	<b>Applicant(s)</b> MARCADE ET AL.	
	<b>Examiner</b> David H. Willse	<b>Art Unit</b> 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 67-72 and 74-82 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 67-72 and 74-82 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 67-72 and 74-82 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The newly added language “being mated” (claim 67, line 8) in conjunction with “after the body is placed in vasculature” (claim 67, line 9) renders the claims confusing as to the scope in that there is uncertainty as to whether the implanted state, and hence the actual engagement (or mating) of the extender with the first leg, is positively recited, or whether the conditional statement “after the body is placed in vasculature” broadly encompasses a functional interpretation similar to that previously addressed by the Board of Patent Appeals and Interferences and by the examiner. Both the preamble and the first section of the body of claim 67 (along with various dependent claims) employ functional language, with the term “configured” (claim 67, line 5) establishing a positional *capability* for the legs relative to vasculature rather than the actual inserted state.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 67-72 and 74-82 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The broadest reasonable interpretation of the claimed invention as a whole possibly encompasses the functional capability discussed above and in previous actions and *definitely*, according to the Applicant (Applicant’s reply of February 26, 2009: page 4, last full paragraph), encompasses the actual mated insertion within vasculature of a

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human or other animal so that the claims are broad enough to cover a human in combination with the device (because both are necessarily present and engaged with one another during an implanted, mated state). Therefore, under MPEP § 2105, last paragraph, the claims are drawn to non-statutory subject matter involving a human being.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 67-72 and 74-82 are rejected under 35 U.S.C. 102(e) as being anticipated by Martin, US 5,653,743, for reasons presented in the Examiner's Answer of May 25, 2006. The Decision on Request for Rehearing of December 30, 2008, states that "Martin does contemplate that the length of short tube graft 8 might, in some instances, be longer than that length which terminates in the opening 6, thus making short tube graft 8 the longer leg" (page 4, lines 4-7). Therefore, Martin anticipates the claims even if the scope were to encompass only the mated, implanted state (and not unassembled or non-implanted states).

The Applicant's remarks have been considered. The Applicant asserts that "the phrase 'being mated with the first leg after the body is placed in vasculature' describes an actual engagement of the extender with the first leg" (Applicant's reply of August 18, 2009: page 2, lines 16-18). However, since the body (and hence the first leg) is in vasculature (possibly that of a human being), the Applicant's reasoning demonstrates that the claims are drawn to non-statutory subject matter, as further explained above and in the Office action of May 18, 2009.

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Moreover, the fact that the Applicant does *not* employ language such as “, the body having been placed in vasculature” rather than the current “after the body is placed in vasculature” (claim 67, last line) likewise demonstrates that the claims are confusing as to the scope, as evidenced by the Applicant’s own remarks (Applicant’s reply of August 18, 2009: page 3, second and third paragraphs). If the body is placed in vasculature, then it is necessarily *mated* with the vasculature (in light of the Applicant’s specification and the context of the present claims).

Regarding the Martin patent, the fact that tube graft **8** is disclosed as being “short” (Martin: column 3, line 1) does *not* imply that the other leg cannot be even shorter. And as noted in the Examiner’s answer of May 25, 2006 (at page 3, lines 11-15), the extender **18** is sized, shaped, and formed such that it is *capable* of mating with either leg (under the *broadest* reasonable interpretation of the claims: MPEP § 2111).

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse, whose telephone number is 571-272-4762 and who

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is generally available Monday, Tuesday, and Thursday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

**/David H. Willse/  
Primary Examiner  
Art Unit 3738**